

**REMARKS**

The Office Action dated October 6, 2005, has been received and carefully considered. It is believed that this Amendment, in conjunction with the following remarks, place the application in immediate condition for allowance. Accordingly, entry of this Amendment and favorable reconsideration of the application are respectfully requested.

I. THE PATENTABILITY REJECTION OF CLAIMS 1-13, 14-19, 21-29, 31-54 AND 56-108

On page 2 of the Office Action, claims 1-13, 14-19, 21-29, 31-54 and 56-108 were rejected under 37 CFR §101 as being unpatentable for being directed to non-statutory subject matter.

Applicant has amended each of independent claims 1, 40, 63 and 87-89 to recite “use of a data processor.” Applicant respectfully submits that independent claim 23 already recites appropriate language so amendment is not required. All other claims depend from claims 1, 23, 40, 63 ,87, 88 or 89, so they incorporate the “use of a data processor” recitation. Accordingly, Applicant respectfully submits the patentability rejection has been overcome.

In view of the foregoing, it is respectfully requested that the aforementioned patentability rejection to claims 1-13, 14-19, 21-29, 31-54 and 56-108 be withdrawn.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 1-13, 14-19, 21-29, 31-54 AND 56-108

On page 3 of the Office Action, claims 1-13, 14-19, 21-29, 31-54 and 56-108 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McMullin (U.S. Patent No. 6,222,914) in view of Bartoli (U.S. Patent No. 6,047,268). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Regarding independent claims 1, 23, 40, 63 and 87-89, the Examiner asserts that McMullin fails to explicitly teach designating a theme comprising a plurality of items offered by a plurality of providers wherein each item comprises at least one of a good and a service and each provider comprises one of a merchant and service provider. However, the Examiner asserts that Bartoli makes up for McMullin's deficiency in this regard. The Examiner alleges that "it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of McMullin to include designating a theme comprising a plurality of items offered by a plurality of providers wherein each item comprises at least one of a good and service and each provider comprises one of a merchant and service provider taught by Bartoli in order to bill a user for transactions for services and or goods provided and or ordered over the Internet."

However, Applicant respectfully submits that Bartoli does not teach or suggest "designating a theme comprising a plurality of items offered by a plurality of providers, wherein each item comprises at least one of a good and a service, and each provider comprises at least

one of a merchant and a service provider,” as recited in independent claim 1, for example.<sup>1</sup> First, Applicant respectfully submits that Bartoli merely discloses a method and apparatus for billing transactions conducted over the Internet. In particular, as described in Baqrtoli’s Abstract, Bartoli relates to a method and apparatus for authenticating transactions using “cookies,” and thus does not teach or suggest any feature or functionality that “designat[es] a theme comprising a plurality of items offered by a plurality of providers,” as required by each of the independent claims:

A method and apparatus for authenticating transactions accomplished over a data network utilizes a "cookie" containing both static information (user-identifying information) and dynamic information (transaction-based information). The transaction-oriented dynamic information portion comprises a random number and a sequence number, the latter tracking the number of billing transactions conducted by the user associated with the account number. The cookie, sent to the user's cookie file upon a previous transaction, is valid for only a single new transaction. A billing server, upon receiving the cookie containing the static and dynamic information portions, identifies the user from the account number in the static portion and accesses from an associated database the expected random number and sequence number that the billing server last sent to that user in the transaction-oriented dynamic portion. If the expected dynamic portion matches the received dynamic portion, the user is authenticated to proceed with the current transaction.

See Bartoli Abstract (emphasis added). Applicant respectfully submits that the balance of Bartoli’s specification similarly fails to teach or suggest the specific step of “designating a theme comprising a plurality of items offered by a plurality of providers, wherein each item comprises at least one of a good and a service, and each provider comprises at least one of a merchant and a service provider.”

Second, Applicant respectfully submits that the Office Action’s detailed description allegedly showing how Bartoli discloses the claim recitation does not in fact demonstrate any

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<sup>1</sup> Applicant respectfully submits that independent claims 23, 40, 63 and 87-89 recite similar language.

feature or functionality that even remotely relates to the step of “designating a theme comprising a plurality of items offered by a plurality of providers, wherein each item comprises at least one of a good and a service, and each provider comprises at least one of a merchant and a service provider.” Rather, Applicant respectfully submits that the description provided in the Office merely demonstrates Bartoli relevance to authentication techniques, not the specific step of “designating a theme comprising a plurality of items offered by a plurality of providers,” as required by each of the independent claims:

However, Bartoli discloses the merchant’s server associates the number telephone call with the request via the Internet for the goods or services in order to authenticate and authorize the transaction. [A] method of billing for transactions conducted over the Internet is disclosed in which a billing server connected on the Internet receives the IP address assigned to that user’s client for the current user session and an indication of the user’s identity from the user/customer’s Internet Access Provider (IAP). In response to a chargeable transaction, the merchant’s server transmits to a billing platform the IP address identity of the user making the transaction and the cost associated with the transaction. The billing server then cross-references the IP address associated with the cost of the transaction received from the merchant’s server with the IP-address/user-identity relationship received from the IAP to properly charge an established account of the user for the transaction. Such an account is established by the user prior to the execution of the transaction for billing in a predetermined manner to, for example, the user’s selected credit card, the user’s debit card, the user’s telephone account associated with his or her number, the user’s merchant credit card, or other billing mechanism. For this billing methodology, arrangements thus need be established between billing server and the large number of different Internet Access Providers that provide Internet access to a tremendously large customer base since for each user’s session the IAP must be programmed to forward to the appropriate billing server the relationship between the user’s currently assigned IP address and identity.

See Office Action, Page 4, 2<sup>nd</sup> ¶ (emphasis added).

Applicant is perplexed at how the above description of Bartoli demonstrates disclosure of the specific recitation “designating a theme comprising a plurality of items offered by a plurality of providers, wherein each item comprises at least one of a good and a service, and each provider comprises at least one of a merchant and a service provider.” In particular, Applicant

respectfully submits that the above description does not teach or suggest any feature or functionality that designates a theme, much less a theme comprising a plurality of items offered by a plurality of providers, wherein each item comprises at least one of a good and a service, and each provider comprises at least one of a merchant and a service provider, as required by each of the independent claims. Accordingly, Applicant respectfully submits that the proposed combination of McMullin and Bartoli fails to teach or suggest each and every recitation of the pending independent claims.

Further, Applicant respectfully submits that the alleged motivation cited in the Office Action would not in fact motivate one of ordinary skill in the art to combine the references to achieve the claimed invention. First, McMullin relates to a system and method for administration of an incentive award system having a delayed award payment using a credit card, and thus would not benefit from -- and indeed has no need for -- Bartoli's method and apparatus for authenticating transactions over a data network using "cookies." Second, even if the references were combined, they would not -- as set forth above -- achieve each and every recitation of the claimed invention. Accordingly, Applicant respectfully submits that independent claims 1, 23, 40, 63 and 87-89 are allowable over the cited references.

Claims 2-12, 14-19, 21-22, 24-29, 31-39, 41-54, 56-62, 64-86 and 90-108 are dependent upon independent claim 1, 23, 40, 63 or 87-89. Thus, since independent claims 1, 23, 40, 63 and 87-89 should be allowable as discussed above, claims 2-12, 14-19, 21-22, 24-29, 31-39, 41-54, 56-62, 64-86 and 90-108 should also be allowable at least by virtue of their dependency on independent claim 1, 23, 40, 63 or 87-89. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 91 recites "wherein the act of defining the thematic rewards

program comprises: receiving a designation of the plurality of items, the designation of the plurality of items being consistent with a theme associated with the thematic rewards program.”

Applicant respectfully submit that the cited references, alone or in combination, fail to teach or suggest the method of independent claim 89 wherein the act of defining the thematic rewards program comprises: receiving a designation of the plurality of items, the designation of the plurality of items being consistent with a theme associated with the thematic rewards program.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-13, 14-19, 21-29, 31-54 and 56-108 be withdrawn.

### III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

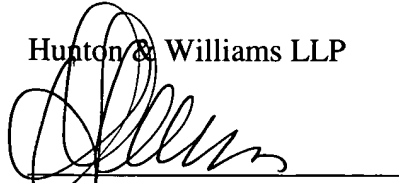
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By:

A handwritten signature in black ink, appearing to read "Ozzie A. Farres", is written over a horizontal line.

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